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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/981,696
Filing Date: October 16, 2001
Appellant(s): KAWAI, EIJI

Peter C. Yi
Reg. No. 61,790
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/21/2008 appealing from the Office action mailed 3/25/2008.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Treyz et al. (US 6,587,835 B1)

Gershman et al. (US 6,401,085 B1)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5, 8-14, 19-21, 24-32, and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al. (US 6,587,835 B1) in view of Gershman et al. (US 6,401,085 B1).**

3. As per **independent Claim 1**, Treyz discloses an electronic guide information processing system for electronically processing guide information about a customers attracting facility having an entrance and an exit (inherent to any public facility, Fig

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- 10), comprising: an information distributing apparatus for converting the guide information into electronic guide information (store computer, data configuration for transmission), and then distributing the electronic guide information (transmitting data, Fig.2, Fig.13); a portable terminal apparatus for recording and presenting the electronic guide information for an information user (Figs.1, 2, 13, 37, 42; C13, data transmission; C34-37), and an information processing apparatus comprising an information collecting apparatus for collecting the electronic guide information from the portable terminal apparatus at the exit (collecting data is equivalent to deleting/erasing the data as claimed in the next step; C49, shopping assistance link deleted/collected along with icon/descriptive information – once user out of range or has exited the facility), the information processing apparatus erasing the electronic guide information from the portable terminal apparatus at an exit of the facility (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility).
4. Furthermore, while Treyz does not expressly disclose sending information to the user in a “batch” format at a specific location (exit), Treyz does disclose continuously sending financial transaction information to the user device, indicating where and what the user did with the system (C46 L9-42).
 5. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the information to the user at specific times and locations as a way to decrease transmission costs; Although, due to the extremely low cost of transmitting data, the Examiner believes the system/method described by

Treyz to be an advancement to that described by the instant invention, as a way to constantly maintain up-to-date real-time information.

6. Treyz fails to expressly disclose wherein the information is transmitted to the customer users using encryption/decryption technology.
7. Gershman discloses using encryption/decryption technology to transmit information wirelessly to customers (Fig.27A-27B)
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included transmitting information to the customer users using encryption/decryption technology, as disclosed by Gershman in the system disclosed by Treyz, for the advantage of providing a method of providing guide information, with the ability to increase system security and information integrity by providing information to users in a secure manner (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
9. As per **independent Claim 5**, Treyz discloses an electronic guide information processing system for processing guide information about a customers attracting facility which restricts the customers to go in and out of the customers attracting facility only through its entrance and exit (common amusement park customer ticketing/access control, Treyz discloses ticketing elements), the system comprising: an information lending apparatus for converting the guide information into electronic guide information, and lending the electronic guide information, to an information user (Kiosk, C22 L43-54; or Transmission of electronic guide information once user

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is within range, C22 L16-42); a portable terminal apparatus for recording and presenting the electronic guide information which has been lent from the information lending apparatus (Fig.13, Handheld computing device); and an information collecting apparatus for collecting at the exit (collecting data is equivalent to deleting/erasing the data as claimed in the next step; C49, shopping assistance link deleted/collected along with icon/descriptive information – once user out of range or has exited the facility), the electronic guide information which has been lent to the portable terminal apparatus (Transmission system or kiosks), wherein, when the electronic guide information is collected at the exit, the electronic guide information is erased at the exit (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility); and wherein reading of the electronic guide information is permitted at the entrance, while the reading of the electronic guide information is inhibited at the exit (Reading of Guide information is within transmission range – which can be configured to be at entrance/exit to a facility, C23 L8-35).

10. Furthermore, while Treyz does not expressly disclose sending information to the user in a “batch” format at a specific location (exit), Treyz does disclose continuously sending financial transaction information to the user device, indicating where and what the user did with the system (C46 L9-42).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the information to the user at specific times and locations as a way to decrease transmission costs; Although, due to the extremely low

- cost of transmitting data, the Examiner believes the system/method described by Treyz to be an advancement to that described by the instant invention, as a way to constantly maintain up-to-date real-time information.
12. Treyz fails to expressly disclose wherein the information is transmitted to the customer users using encryption/decryption technology.
 13. Gershman discloses using encryption/decryption technology to transmit information wirelessly to customers (Fig.27A-27B)
 14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included transmitting information to the customer users using encryption/decryption technology, as disclosed by Gershman in the system disclosed by Treyz, for the advantage of providing a method of providing guide information, with the ability to increase system security and information integrity by providing information to users in a secure manner (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
 15. As per **independent Claim 19**, Treyz discloses a portable terminal apparatus for obtaining and processing electronic guide information about a customer attracting facility (Fig.13, Handheld computing device) having an entrance and an exit (inherent to any public facility, Fig 10), the apparatus comprising a manipulating section (Computer, Fig.13); a receiving section (Fig.13, Handheld computing device); a nonvolatile storing apparatus (Handheld computing device – memory; or system server); and a controlling apparatus (system server collects user information, C46).

16. As for the limitations of the functions of the apparatus or what the apparatus does, i.e.
 - “when the electronic guide information about the customers attracting facility is collected, erasing the electronic guide information,” these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures or structural elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).
17. Furthermore, Treyz fails to expressly disclose wherein the information is transmitted to the customer users using encryption/decryption technology.
18. Gershman discloses using encryption/decryption technology to transmit information wirelessly to customers (Fig.27A-27B)
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included transmitting information to the customer users using encryption/decryption technology, as disclosed by Gershman in the system disclosed by Treyz, for the advantage of providing a method of providing guide information, with the ability to increase system security and information integrity by providing information to users in a secure manner (See *KSR* [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
20. As per **independent Claim 28**, Treyz discloses a method for processing electronic guide information which electronically processes guide information about a customers attracting facility having an entrance and an exit (inherent to any public facility, Fig 10), the method comprising the steps of: producing electronic guide

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information at an information provider side by converting the guide information (store computer, data configuration for transmission), and distributing the electronic guide information to a portable terminal apparatus carried by an information user (transmitting data, Fig.2, Fig.13); obtaining the distributed electronic guide information at the information user side (send and receive transmission); presenting the obtained electronic guide information to the information user (C1-C2); collecting the electronic guide information from the portable terminal apparatus at the exit (collecting data is equivalent to deleting/erasing the data as claimed in the next step; C49, shopping assistance link deleted/collected along with icon/descriptive information – once user out of range or has exited the facility); erasing the electronic guide information from the portable terminal apparatus at an exit from the facility (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility).

21. Furthermore, while Treyz does not expressly disclose sending information to the user in a “batch” format at a specific location (exit), Treyz does disclose continuously sending financial transaction information to the user device, indicating where and what the user did with the system (C46 L9-42).

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the information to the user at specific times and locations as a way to decrease transmission costs; Although, due to the extremely low cost of transmitting data, the Examiner believes the system/method described by

- Treyz to be an advancement to that described by the instant invention, as a way to constantly maintain up-to-date real-time information.
23. Treyz fails to expressly disclose wherein the information is transmitted to the customer users using encryption/decryption technology.
24. Gershman discloses using encryption/decryption technology to transmit information wirelessly to customers (Fig.27A-27B)
25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included transmitting information to the customer users using encryption/decryption technology, as disclosed by Gershman in the system disclosed by Treyz, for the advantage of providing a method of providing guide information, with the ability to increase system security and information integrity by providing information to users in a secure manner (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
26. As per **independent Claim 32**, Treyz discloses a method for processing electronic guide information which processes electronic guide information about a customers attracting facility which restricts the customers to go in and out of the customers attracting facility only through its entrance and exit (common amusement park customer ticketing/access control, Treyz discloses ticketing elements), the method comprising the steps of: lending the electronic guide information at the entrance to a portable terminal apparatus carried by an information user (transmitting guide information – links, icon, C49); collecting, at the exit, the electronic guide

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- information which has been lent to the portable terminal apparatus (collecting data is equivalent to deleting/erasing the data as claimed in the next step; C49, shopping assistance link deleted/collected along with icon/descriptive information – once user out of range or has exited the facility); erasing the lent electronic guide information at the exit from the portable terminal apparatus (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility).
27. Furthermore, while Treyz does not expressly disclose sending information to the user in a “batch” format at a specific location (exit), Treyz does disclose continuously sending financial transaction information to the user device, indicating where and what the user did with the system (C46 L9-42).
28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the information to the user at specific times and locations as a way to decrease transmission costs; Although, due to the extremely low cost of transmitting data, the Examiner believes the system/method described by Treyz to be an advancement to that described by the instant invention, as a way to constantly maintain up-to-date real-time information.
29. Treyz fails to expressly disclose wherein the information is transmitted to the customer users using encryption/decryption technology.
30. Gershman discloses using encryption/decryption technology to transmit information wirelessly to customers (Fig.27A-27B)

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included transmitting information to the customer users using encryption/decryption technology, as disclosed by Gershman in the system disclosed by Treyz, for the advantage of providing a method of providing guide information, with the ability to increase system security and information integrity by providing information to users in a secure manner (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

(10) Response to Argument

1. The Appellant has made the argument that the cited prior art of Treyz and Gershman fail to teach or disclose erasing the electronic guide information from the portable terminal apparatus at an exit of the facility and writing in the portable terminal apparatus information about the information user’s use of the customers attracting facility at the exit.
2. However, Treyz does disclose shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility (C49).
3. Furthermore, while Treyz does not expressly disclose sending information to the user in a “batch” format at a specific location (exit), Treyz does disclose continuously sending financial transaction information to the user device, indicating where and what the user did with the system (C46 L9-42).

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4. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the information to the user at specific times and locations as a way to decrease transmission costs; Although, due to the extremely low cost of transmitting data, the Examiner believes the system/method described by Treyz to be an advancement to that described by the instant invention, as a way to constantly maintain up-to-date real-time information.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

November 15, 2008

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Primary Examiner, Art Unit 3629

Conferees:

/Jamisue A. Plucinski/

Primary Examiner, Art Unit 3629

Application/Control Number: 09/981,696

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